



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

YAMAGUCHI et al.

Atty. Ref.: 2018-743; Confirmation No. 1319

Appl. No. 10/622,660

TC/A.U. 1723

Filed: July 21, 2003

Examiner: T. Cecil

For: FILTER HAVING HOLES IN FILTER SECTION THEREOF

* * * * *

April 3, 2008

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

**PETITION UNDER 37 CFR §1.181 FOR REVIEW OF THE EXAMINER'S
DECISION TO REFUSE ENTRY OF THE AMENDMENT FILED JANUARY 31, 2008**

It is respectfully requested that the Examiner's Decision to refuse entry of the Amendment filed under Rule 116 on January 31, 2008, as reported in the Advisory Action of March 20, 2008, be reviewed and reversed on the basis of the following:

During a telephone interview on December 21, 2007, the Examiner advised that if claims 31-34 were canceled, the remaining claims 1-8, 10-11 and 17-30 would be allowed over Verlag (XP '379). Subsequently, on or about December 27, 2007, the Examiner advised that while he had determined that the noted claims (1-8, 10-11 and 17-20) were allowable over Verlag (XP '379), a rejection of those claims might be made based on GB 2324571.

On December 27, 2007, an amendment was filed presenting the arguments presented during the telephone interview of December 21, 2007, and canceling claims

31-34, as the Examiner suggested, to secure withdrawal of the rejection based on Verlag (XP '379).

On January 10, 2008, the Examiner issued an Advisory Action advising that the amendment (cancellation of claims 31-34) would be entered upon appeal, but the Examiner maintained the rejection based on Verlag (XP '379).

Because, contrary to the representations during the telephone interviews of December 21 and December 27, 2007, the Examiner decided to maintain the rejection based on Verlag (XP '379) and because claims 31-34 were canceled solely because the Examiner had indicated that the remaining claims would be allowable over Verlag (XP '379) if those claims were canceled, on January 31, 2008 a further amendment under Rule 116 was filed, re-introducing previously canceled claims 31-34 as new claims 35-38 so that they could be included in applicant's appeal, in the event the Examiner continued to maintain the rejection based on Verlag (XP '379). Entry of claims 35-38 as a reintroduction of claims 31-34 was believed appropriate because, as noted, those claims were earlier canceled solely because of the Examiner's representation that the Verlag rejection of the remaining claims would be withdrawn if those claims were canceled. The reintroduction of claims 31-34 raised no new issues as they were previously considered by the Examiner and received an action on the merits.

On March 20, 2008 the Examiner issued a further Advisory Action refusing to enter the amendment filed January 31, 2008, alleging that the amendment was "not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal".

While it is understood that applicant cannot "as a matter of right" add new claims after a final rejection to reinstate previously canceled claims, it is believed that the present case is a circumstance in which re-introduction of such claims should be permitted because that amendment only required a cursory review by the Examiner to confirm that the new claims corresponded to the previously canceled claims. Moreover,

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as noted, those claims were canceled solely because of the Examiner's assurance that the remaining claims were allowable over the applied Verlag publication. To conclude otherwise would unfairly and unjustly prejudice applicant.

For all the reasons advanced above, it is clear that the Examiner's refusal to permit reintroduction of claims corresponding to claims 31-34 was inappropriate and unjust under the circumstances of this particular case, and should be overruled and reversed.

For all the reasons advanced above, reversal of the Examiner's decision refusing entry of the January 31, 2008 amendment and entry of that amendment for purposes of appeal is solicited.

Should a fee be required for this Petition to be considered and granted, please charge the fee to our Deposit Account 14-1140 under Order No. 2018-743.

Respectfully submitted,

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